

### **REMARKS**

By way of the present response, claims 1, 4, 6, 8, 11, 13, 14, 17, 19, 20 and 23-28 are amended. These amendments are supported in the original specification and drawings, for example, in paragraphs 0025, 0030 and 0031. In view of these amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

Starting on page 2, the Office rejects claims 23-28 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Office objected to the phrase “the usage results” for lacking antecedent basis. In response, Applicants have amended claims 23-28 to recite “inference results, which has antecedent basis in independent claims 1, 8 and 14. Additionally, claims 4, 6, 11, 13, 17 and 19 are amended to change the recitation “the usage results” in a analogous fashion. Applicants submit that all pending claims now fully comply with Section 112, second paragraph. Accordingly, it is believed this rejection should be withdrawn.

On pages 2 to 4, the Office maintained the rejection of claims 1-19 and 23-28 under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U.S. Patent 6,466,915). With respect to claims 1, 8 and 14, the Office asserts that Figure 1 of the Suzuki patent illustrates a first device in the form of a terminal 100, and that the terminal is a computer terminal and thus inherently includes a digital content storage system in the form of an internal memory. The Office goes on to assert, “The graphical user interface of Figure 25 is a monitoring system that appears on the terminal and monitors the selection of specific files, such as the selection of ‘flower pattern one-piece dress.’ Making the selection generates usage data, such as color, size, price and quantity purchased, which are subsequently sent to the central processing center (100) in Fig. 1. The data fields, such as the data fields containing the named color “pink” and the price “6.800” are the usage data storage system since these fields store the usage data until it is sent to the central processing center (100) in Fig. 1. FIG.11 illustrates a table which forms the usage metrics system. The table permits inferred conclusions, such as the conclusion that a customer prefers a particular size, as illustrated at C in FIG. 7C and described at col. 18, lines 1-6. The table of FIG. 11 is located

in the order reception file (3) (col. 13, lines 66-67) which is part of the central processing center (100) and forms a second device remote from the first device (terminal 200).”

However, the Suzuki et al. patent does not describe a system including “a monitoring system that monitors, at the first device, consumption of digital content of a file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed, wherein said selection of said file does not involve an online session with a goods or services provider ...,” as now recited in the context of the other features of amended claim 1, or a process of “monitoring, by the first device, consumption of digital content of the stored digital content files, which are selected from the digital content storage for consumption, wherein said selection of said file does not involve an online session with a goods or services provider,” as now set forth in amended independent claims 8 and 14. In direct contradistinction to the presently claimed subject matter, a selection of an item displayed on the computer terminal 200 of Suzuki et al. (e.g., “flower pattern one-piece dress”) would occur *during an online session* with a goods provider (e.g., see column 1, lines 7-13, and column 2, lines 30-38), or would otherwise be automatically determined from the customer’s buying history data compiled from one or more previous sessions (column 17, line 65 to column 18, line 6). This is fundamentally different from the claimed system, method and instructions in a computer readable medium in which a file is selected offline from a goods or services provider, from digital content *stored* in digital content storage of a device (e.g., already downloaded to a users device), and in which consumption of the digital content of that file is monitored to generate usage data, which is collected and processed to provide inference results.

Indeed, the presently recited subject matter of claims 1, 8 and 14 provides a way to monitor, at a device, consumption of different types of digital content, such as audio files, text files, e-books, video format files, multimedia, pictures, executable code, software or combinations thereof, *after* it is receiving and stored in the device. This usage data is collected and processed to provide inference data in a way not provided by the system of Suzuki et al., which gathers history data relating to selected and purchased goods only at the time of browsing or purchasing online. For example, there appears to be no mechanism in Suzuki et al. to compile history data for items already obtained, such as how many times a

purchased flower pattern dress is worn by a customer. Thus, it is respectfully submitted that the Suzuki et al. patent fails to describe or suggest the combinations of features recited in each of claims 1, 8 and 14.

Claims 2-7, 9-13, 15-19 and 23-28 each depend from one of independent claims 1, 8 and 14, and are therefore allowable for at least the reasons pointed out above, and further for the additional features recited.

The action also includes a rejection of claims 20-22 under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent 6,466,915) in view of Henrick (U.S. Patent 6,507,727). This rejection is respectfully traversed.

With respect to claim 20, which is now rewritten in independent format, the Office asserts that Figures 5A-5C of the Henrick patent illustrate a portable device that can download digital audio content, such as a song file (“download song”) that can be purchased (abstract, line 1). Next, the Office concludes that it would have been obvious to one of ordinary skill in the art to modify the terminal (200) of Suzuki et al. to be a portable cellular terminal configured to additionally download audio content as taught by Henrick so as to permit portability of the terminal and permit both physical items (clothing) and digital content (songs) to be purchased from the same system. To the contrary, Applicants submit that there is no suggestion in either of the Suzuki et al. or Henrick patents of the claimed combination of features comprising first device, which includes “digital content storage that stores digital content files ... a monitoring system that monitors, at the first device, consumption of digital content comprising an audio file selected from the digital content storage, and generates usage data based on one or more usage events and indicative of the manner in which the digital content is consumed,” and “a usage data storage system that collects the usage data ... a usage metrics system at a second device remote from the first device that receives the stored usage data and processes the usage data to provide inference results,” as recited in claim 20.

As recognized by the Office, the Suzuki et al. patent neither discloses nor suggests “a monitoring system that monitors, at the first device, consumption of digital

content comprising an audio file selected from the digital content storage ....” Even more importantly, the Suzuki et al. patent does not recognize the problem that the invention addresses, i.e., the tracking at a device the consumption of digital content comprising an audio file (e.g., music) that is stored in a digital content storage of the device.

The Henrick patent does not remedy the shortcomings of the Suzuki et al. patent. Although Henrick describes a system that may facilitate the purchase and delivery of audio content over the Internet, there is no mention whatsoever in Henrick of monitoring “consumption of digital content comprising an audio file selected from the digital content storage ...,” as claimed. Moreover, there is no recognition of problems relating to monitoring consumption of audio digital content once it has been received by a consumer. Rather, Henrick describes a system in which a user listening to a song or album on the radio or watching video may enter a request, via a wireless device such as a cell phone, to download that song, album or digital video to another device (e.g., a PC) (see, column 1, line 61 to column 2, line 11). After a download is complete, “the user’s service account is changed and any required payments are made to the content owners or download source.” Thus, while the Henrick patent describes ways to facilitate downloads, there is no suggestion in Henrick of monitoring the downloaded digital content, as set forth in claim 20.

In contrast to the methods and systems of the prior art used to determine consumption of digital content, such as download statistics or other bottom line sales data that provide minimal insight into a user or customer’s likes or dislikes, the claimed subject matter provides a system in which audio digital content is monitored to generate usage data based on one or more usage events and indicative of the manner in which the digital content is consumed, and a system that processes this usage data to enable making inferences based on these data. There is simply no teaching, suggestion or motivation within these references themselves to combine the various features disclosed therein in the manner recited in claim 20. While the Examiner recognizes the necessity of finding such a motivation, on page 5 of the office action, he fails to find it in the references themselves, and instead relies upon the teachings in the Applicants’ own specification for the requisite teachings, suggestions and motivations to combine these references. Without the recognition of the above-mentioned problem, there is simply no incentive, motivation or teaching in the prior art to combine the

elements of the Suzuki et al. and Henrick to arrive at the invention defined in claim 20. As such, the facts of the instant case parallel those of *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969), which held:

[I]t should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is *part* of the ‘subject matter as a whole’ which should always be considered when considering the obviousness of an invention under 35 USC Section 103...The court must be ever alert not to read obviousness into an invention on the basis of an applicants own statements; that is, we must view the prior art without reading into that art Appellant’s teachings.

Applicants submit that without a recognition of the problem that the instant invention solves, that there is simply no incentive, teaching or motivation for the Examiner to combine the references in such a way as to arrive at the invention recited in claim 20. And as such a teaching, motivation or incentive is present only in Applicants’ own specification, Applicants submit that the rejection of claim 20 under 35 U.S.C. § 103 should be withdrawn.

Claims 21 and 22 depend from independent claim 1, and are allowable for at least the reasons set forth above with respect to claim 1, and further because the Henrick patent fails to teach or suggest anything with regard to monitoring consumption of digital content as presently claimed.

In view of all of the foregoing, Applicants submit that this application is now in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: November 6, 2006

/John F. Guay, Reg.# 47248/  
John F. Guay

NIXON PEABODY LLP  
c/o Gunnar G. Leinberg, Reg. No. 35,584  
Clinton Square, P.O. Box 31051  
Rochester, New York 14603-1051  
Telephone: (585) 263-1014  
Facsimile: (585) 263-1600